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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,811	07/27/2000	Kotaro Oami	5000-4777	9671
27123	7590	12/14/2004	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			RHEE, JANE J	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/626,811

Applicant(s)

OAMI ET AL.

Examiner

Jane Rhee

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/1/2004 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 7-16 have been considered but are moot in view of the new ground(s) of rejection.

New Rejections

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 7,10-11,13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon (4101701).

Gordon discloses a resin panel body (figure 5 number 26), an insert film (figure 5 numbers 18,16,24 combined) arranged on a surface of the resin panel body (figure 5 number 26), the insert film comprising a resin film (figure 5 number 24), a first binder

layer formed on the surface of the resin film (figure 5 number 16), a printed part formed on the first binder layer (figure 5 number 12), a second binder layer formed so as to seal the printed part in co-operation with the first binder layer (figure 5 number 16) and the second binder layer contacting the first binder layer along a periphery of the printed part (figure 5 number 18, 16), wherein the first binder layer, the printed part and second binder layer are formed in this order (figure 5 numbers 18,12,16); and wherein the printed part adheres to the first binder (figure 5 number 12). Gordon discloses that the material of the resin panel body is the same as that of the resin film (col. 4 line 54-56, col. 8 line 22-23). Gordon discloses that the periphery of the second binder layer is printed to overlap the periphery of the first layer (figure 5 numbers 18 and 16). Gordon discloses that the printed part is coated along the periphery of the insert film (figure 5 number 12) Gordon discloses that the printed part consists entirely of ink (col. 3 line 65). Gordon discloses that the printed part adheres to the second binder layer (figure 5 number 12 and 18).

As to the claim wherein the resin panel is a window for automobiles, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either

identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation wherein the resin body is integrally molded with the insert film by inserting molding so that a surface of the resin film of the insert film at the side on which a printed part is formed faces an inside of the resin panel is a method of production and therefore does not determine the patentability of the product itself.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-9,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon in view of Keng (5362540).

Gordon discloses the resin panel described above. Gordon fail to disclose that the resin panel body is directly adhered closely to the resin film at an outer side of the periphery of the first binder layer or the second binder layer. Gordon fail to disclose that the resin body and the resin film is made from polycarbonate.

Although Gordon fail to disclose that the resin panel body is directly adhered closely to the resin film at an outer side of the periphery of the first binder layer or the second binder layer, he teaches the concept of one layer adhering to outer side of the periphery of another layer in order to directly adhere to a third layer. In other words, when applicant claimed that the resin panel body is directly adhered to the resin film at the outer periphery of the first binder layer, he intends in creating a sandwich like creation wherein two layers are adhered to each other on the outer periphery of the middle layer. So even though Gordon doesn't specifically have the resin panel body layer directly adhered to the resin film at the outer periphery of the first binder layer, he teaches that two layers are adhered to each other on the outer periphery of the middle layer for the purpose of providing effective security heat seal (col. 2 lines 34, figure 5 numbers 12,14,16,18).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide the resin panel body that is directly adhered closely to the resin film at an outer side of the periphery of the first binder layer

or the second binder layer in order to provide a more effective security heat seal (col. 2 line 34).

Keng teaches that the resin panel body is directly adhered closely to the resin film at an outer side of the periphery of the first binder layer (figure 2 number 14 and 19) or the second binder layer (figure 2 numbers 18,12) for the purpose of creating a laminate that provides protection to a document (col. 1 lines 50-53, col. 2 lines 43).

Therefore, it would have been obvious to provide Gordon with the resin panel body that is directly adhered closely to the resin film at an outer side of the periphery of the first binder layer or the second binder layer in order to create a laminate that provides protection to a document (col. 1 lines 50-53, col. 2 line 43) as taught by Keng.

Keng teaches that the resin body and the resin film is made from polycarbonate for the purpose of providing good transparency and the material not to be degraded at laminating temperatures (col. 2 lines 56-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Gordon with the resin body and the resin film that is made from polycarbonate in order to provide good transparency and the material not to be degraded at laminating temperatures (col. 2 lines 56-60) as taught by Keng.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee
November 5, 2004


NASSER AHMAD
PRIMARY EXAMINER 11/10/04